

REMARKS

A Petition for Extension of Time is being concurrently filed with this Amendment. Thus, this Amendment is being timely filed.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

Status of the Claims

In the present Amendment, claims 1, 6 and 9-11 have been amended. Also, claims 2 and 3 were previously canceled without prejudice or disclaimer of the subject matter contained therein. Further, claims 16-19 have been added as being directed to further embodiments of the present invention. This makes claims 1 and 4-19 as pending in the present application.

No new matter has been added by way of the amendment to claim 1 because the amendment is editorial in nature and also supported by original claim 1. Also, the amendment to claim 6 is obviously editorial in nature. Further, the amendments to claims 9-11 actually delete subject matter and also do not add new matter.

No new matter has been added with the addition of claims 16-19. Claims 16-17 have support in originally filed claim 1, except component (B) has support in the present specification at page 9, lines 1-3. Also, claim 18 has support in the specification at the bottom of page 9 and at page 11, line 3 to page 12, line 15. Finally, new claim 19 is supported at page 13, lines 7-36 of the present specification.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw the objection and all other rejections and allow the currently pending claims.

Claim Objections

Claims 1, 4, 5 and 10 stand objected to due to informalities (see paragraph 1 of the Office Action). Applicants respectfully traverse.

With regard to claim 1, "crosslinking" has been changed to "crosslinking agent".

With regard to claim 10, Applicants note that claim 9 refers to a silane or siloxane compound. Thus, claim 10 properly limits claim 9 by only referring to the siloxane compound and does not have exactly the same limitations as recited for component (B) in claim 9.

Accordingly, Applicants respectfully submit that the instant objection has been overcome. Reconsideration and withdrawal of this objection are respectfully requested.

Issues of Double Patenting

Claims 1, 4-10, 12 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/676,146 (see paragraph 2 of the Office Action). This rejection is respectfully traversed. Reconsideration and withdrawal thereof are respectfully requested.

A Terminal Disclaimer is being concurrently filed with this Amendment. Thus, this rejection has been obviated and withdrawal thereof is respectfully requested.

Issues Under 35 U.S.C. § 103(a)

Claims 9-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Aoki (U.S. 2002/0013386 A1; hereinafter referred to as "Aoki '386") in view of newly cited Ushizaka *et al.* (U.S. 5,415,912; hereinafter "Ushizaka '942") (this is a new ground of rejection; see paragraphs 3-6 of the Office Action). This rejection is respectfully traversed, and reconsideration and withdrawal thereof are respectfully requested.

Requirements for a *Prima Facie* Case of Obviousness Not Being Satisfied

In forming the instant rejection, the Examiner cites parts of Aoki '386 and then admits that the primary reference "fails to teach the addition of a silane compound corresponding to applicant's component (B)" (see the Office Action at page 4, lines 19-20). The secondary reference of Ushizaka '912 is cited to account for such deficiencies of the primary reference of Aoki '386. Specifically, the Examiner refers Applicants to column 3, lines 8-13 and column 5, lines 30-48 (citing "methacryloxypropyltrimethoxysilane") of Ushizaka '912 as disclosing Applicants' claimed component (B). However, Applicants respectfully refer the Examiner to independent claims 9 and 11 as presented herein (the other rejected claims depend thereon). As can be seen, there is no overlap of the disputed claims with the cited combined disclosure of Aoki '386 plus Ushizaka '912. Thus, this rejection under § 103(a) has been overcome.

This is because U.S. case law squarely holds that a proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a claimed method or process), there would have been a reasonable expectation of success. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d (BNA) 1438, 1442 (Fed. Cir. 1991); *see also In re Kotzab*, 55 USPQ2d (BNA) 1313, 1316-17 (Fed. Cir. 2000). Here, the cited combination of Aoki '386 and Ushizaka '912 fails to disclose all instantly claimed features, which includes the claimed component (B). Thus, a *prima facie* case of obviousness has not been established. Reconsideration and withdrawal of this rejection are respectfully requested.

Applicants add that the other requirements for a *prima facie* case of obviousness are not satisfied when the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*. That is not the case here. Instead, a conclusion is drawn in the Office Action (at page 5, first full paragraph) that the disclosures could be combined without assessing if, e.g., the single component taken out of Ushizaka '912 would work in the specific combination of those components described in Aoki '386. The primary reference of Aoki '386 discloses specific components in certain amounts, and the skilled artisan would thus would not reasonable expect to be successful in combining an ingredient from a secondary reference due to so much

experimentation involved. In this regard, “Obviousness requires one of ordinary skill in the art have a reasonable expectation of success as to the invention—‘obvious to try’ and ‘absolute predictability’ are incorrect standards.” *Velander v. Garner*, 68, USPQ2d 1769, 1784 (Fed. Cir. 2003) (citing *In re O’Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673 (Fed. Cir. 1988)). Thus, the instant rejection under § 103(a) have been overcome for the additional reason that an improper “obvious to try” rationale is being employed to form the instant rejection.

Applicants also traverse the conclusion in the Office Action at page 5, lines 2-4. Applicants’ traversal is based on how no scientific or technical evidence has been provided to counter the presumption of patentability given to Applicants’ claims.

Reconsideration and withdrawal of this rejection are respectfully requested.

Unexpected Results

Applicants’ previous arguments are rendered moot (see the Office Action at page 6, first full paragraph). Thus, Applicants respectfully submit the following.

The present invention has achieved unexpected results, whereby such results rebut any asserted *prima facie* case of obviousness (whether based on Aoki '386, Ushizaka '912 or any other reference or combinations thereof). See *In re Corkill*, 711 F.2d 1496, 226 USPQ (BNA) 1005 (Fed. Cir. 1985); see also *In re Papesch*, 315 F.2d 381, 137 USPQ (BNA) 43 (CCPA 1963); *In re Wiechert*, 370 F.2d 927, 152 USPQ (BNA) 247 (CCPA 1967). As stated in M.P.E.P. § 2144.09 (see section entitled “*Prima Facie* Case Rebuttable By Evidence of Superior

or Unexpected Results”), any rejection under 35 U.S.C. § 103(a) may be rebutted by a sufficient showing of unexpected results for the present invention.

Regarding unexpected results, the silicone adhesive of the present invention exhibits initial tackiness (or pressure-sensitive adhesion) sufficient to fixedly secure the substrate that allows a desired step, such as cutting or the like, to be performed on the substrate. In addition, by press bonding another substrate to the adhesive-bearing substrate and heating them, the substrates can be firmly bonded together. In addition, the inventive adhesive contains, as the adhesive aide, component (B) so that the cured composition exhibits permanent adhesion. The tested and measured properties of the present invention are depicted in, e.g., Table 1 on page 20 of Applicants' specification. As can be seen from such experimental data, the present invention unexpectedly achieves improved adhesiveness or bonding strength (MPa) under certain conditions versus both Comparatives Examples 1 and 2.

Regarding these Comparative Examples in Applicants' specification, the Aoki '386 composition actually corresponds to Comparative Examples 1 and 2 in the present specification (see, e.g., the specification describing Comparative Example 1 at page 18, lines 17-18). Again, Aoki '386 is deficient in its disclosure by not claiming the instantly claimed component (B). Applicants note that a comparative showing need not compare the claimed invention with all of the cited prior art (e.g., Aoki '386 and Ushizaka '912), but only with the closest prior art. *See* M.P.E.P. §§ 716.02(b) and 716.02(e); *see also In re Fenn et al.*, 208 USPQ 470 (CCPA 1981); *In re Holladay*, 199 USPQ 516 (CCPA 1978). Here, the Comparative Examples (as corresponding to Aoki '386) in the present specification demonstrate inferior adhesiveness when compared to

the present invention (see the adhesiveness or bond strength values in Table 1 on page 20). Or, the present invention is unexpectedly superior and improves upon the Comparative Examples.

Applicants also note that superiority can establish unexpected results. *See In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987). Again, Table 1 depicts such superior properties versus the Comparative Examples, which corresponds to the Aoki '386 embodiment.

Therefore, the disputed claims 9-15 are patentably distinguishable over Aoki '386 (whether in combination with Ushizaka '912 or not). Reconsideration and withdrawal of this rejection are respectfully requested.

Summary

Accordingly, the inventive adhesive containing the specific components (A) to (C) and the features thereof are patentably distinct over Aoki '386 and Ushizaka '912, or any other reference or combinations thereof. Also, not all requirements for a *prima facie* case of obviousness have been satisfied and unexpected results exist for the present invention. Thus, reconsideration, withdrawal of this rejection, and early and favorable action on claims 9-15 are respectfully requested.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present

Application No. 10/644,976

Docket No.: 0171-1012P

Art Unit 1712

Reply to Office Action of March 16, 2006

application. Applicants also request favorable action on new claims 16-19. Applicants respectfully request that a timely Notice of Allowance issue for the present case.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact Eugene T. Perez (Reg. No. 48,501) at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

Andrew D. Meikle

Registration No.: 32,868

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant

Attachment: Terminal Disclaimer